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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,811	11/20/2001	Nick Steele	32052-3312.US09	8011
25096 7590 10/14/2011 PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247				
EXAMINER				
NIGH, JAMES D				
ART UNIT		PAPER NUMBER		
3685				
NOTIFICATION DATE		DELIVERY MODE		
10/14/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[patentprocurement@perkinscoie.com](mailto:patentprocurement@perkinscoie.com)

**Office Action Summary****Application No.**

09/988,811

**Applicant(s)**

STEELE ET AL.

**Examiner**

JAMES D. NIGH

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 60-71 and 74-87 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 60-71 and 74-87 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☒ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

Paper No(s)/Mail Date: 23 July 2011 and 26 September 2011

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 May 2011 has been entered.

### ***Claim Status***

2. Claims 60, 70 and 77 have been amended. Claims 60-71 and 74-87 are currently pending and are presented for examination on the merits.

### ***Examiner's Comment***

3. Per MPEP § 2106 II C, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

4. Per MPEP § 2106 II C, The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

5. Per MPEP § 2111.04, Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

(A) "adapted to" or "adapted for" clauses;

(B) "wherein" clauses; and

(C) "whereby" clauses.

6. Per MPEP § 2114, apparatus claims must be structurally distinguishable from the prior art "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

7. The language of claim 60 "...the ticket being generated by the client device in response to a selection on the client device selecting one of a plurality of ticket

templates, each ticket template including one or more of a plurality of types of service-provider-access: privileges for a respective one of a plurality of types of service providers, the ticket identifying selected information elements associated with the access privileges and including authorization from the client device for a vendor server to access the selected information elements from an information account associated with the consumer and maintained in a central data repository and accessible via a distributed network, the information account comprising a plurality of consumer information elements accessible and modifiable by the consumer” does not limit the claim as these are only suggested method steps and could be performed prior to the execution of the method. See MPEP § 2106 II C. As claims 70 and 77 contain similar language they are also not limiting per MPEP § 2106 II C.

8. The language of claim 60 “...to complete the transaction” does not limit the claim as this is only a suggested method step per MPEP § 2106 II C.

### ***Response to Arguments***

9. Applicant's argument with regard to the previous rejection of the claims has been fully considered but is moot in view of the new ground(s) of rejection.

### ***Priority***

### ***Continuation-In-Part***

10. This application is a continuation-in-part (“CIP”) application of U.S. application no. 09/974,766 filed on 9 October 2001, now U.S. Patent 7,016,875 (“Parent Application”), and is a continuation-in-part (“CIP”) application of U.S. application no. 09/933,567 filed on 20 August 2001, now U.S. Patent 7,467,141 (“Parent Application”),

and is a continuation-in-part ("CIP") application of U.S. application no. 09/923,285 filed on 9 October 2001, now U.S. Patent 7,257,581 ("Parent Application"), and is a continuation-in-part ("CIP") application of U.S. application no. 10/007,785 filed on 7 November 2001, now U.S. Patent 7,016,877 ("Parent Application"). See MPEP §201.08. In accordance with MPEP §609.02 A. 2 and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in the Parent Application. Also in accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered 'of record' in the Parent Application are now considered cited or 'of record' in this application. Additionally, Applicant(s) are reminded that a listing of the information cited or 'of record' in the Parent Application need not be resubmitted in this application unless Applicants desire the information to be printed on a patent issuing from this application. See MPEP §609.02 A. 2. Finally, Applicants are reminded that the prosecution history of the Parent Application is relevant in this application. See *e.g.*, *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350, 69 USPQ2d 1815, 1823 (Fed. Cir. 2004) (holding that statements made in prosecution of one patent are relevant to the scope of all sibling patents).

11. Applicant's claim for the benefit of U.S. provisional patent application 60/253,298 filed 27 November 2000 under 35 U.S.C. 119(e) is acknowledged.

***Information Disclosure Statement***

12. The information disclosure statements (IDS) were submitted on 28 July 2011 and 26 September 2011. The submissions are in compliance with the provisions of 37 CFR

1.97. Accordingly, the information disclosure statements are being considered by the examiner.

***Specification***

13. The disclosure is objected to because of the following informalities: the original attorney docket number cited in the first related application has changed since the disclosure was filed and should either be updated to reflect the change, or corrected to incorporate a reference to the since assigned application no. 10/007,785.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**15. Claims 77-87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

16. Claim 77 recites a computer readable medium and further recites "...effective to cause a computer to:" As no functional tie-in between the instructions and the computer has been established it is unclear as how a medium with non-functional descriptive material can cause a computer to perform actions "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...", *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

17. Claims 78-87 are also rejected as being dependent upon claim 77.

***Claim Rejections - 35 USC § 102***

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**19. Claims 60, 63-68, 70, 74-78 and 81-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Itabashi et al. (U.S. Patent 6,308,203, hereinafter referred to as Itabashi).**

20. As per claims 60 and 77

Itabashi discloses receiving a ticket at a host server from a consumer via a client device by way of a wireless application gateway to perform a transaction (Figure 4, element S21, 5:38-46, 5:59-67, 8:15-21, 13:61-64)

Itabashi discloses the ticket being generated by the client device in response to a selection on the client device selecting one of a plurality of ticket templates, each ticket template including one or more of a plurality of types of service-provider-access-privileges (Figure 9, elements S81-S87, 6:58-7:7, 11:1-13, 11:28-33)

Itabashi discloses the ticket identifying selected information elements associated with the access privileges and including authorization from the client device for a vendor server to access the selected information elements from an information account associated with the consumer and maintained in a central data repository and



accessible via a distributed network, the information account comprising a plurality of consumer information elements accessible and modifiable by the consumer (Figure 12, 10:44-54, 11:14-27, 12:1-8, 13:49-55)

Itabashi discloses interacting by means of the host server with a vendor server to request the transaction (Figure 4, element S22)

Itabashi discloses accessing by means of the host server the information account to retrieve the selected information elements and providing the selected information elements to the vendor server to complete the transaction (Figure 4, elements S28-S30).

Per claim 77 Itabashi discloses a computer readable medium (14:16-21).

21. As per claims 63 and 81

Itabashi discloses wherein the ticket from the client device further comprises authentication information (7:37-51)

Itabashi discloses wherein the method further comprises authenticating the consumer based on the authentication information prior to interacting with the vendor database (7:37-51).

22. As per claims 64 and 82

Itabashi discloses wherein the authentication information comprises consumer authentication information (7:37-51)

Itabashi discloses wherein authenticating the consumer comprises verifying the consumer authentication information (7:37-51).

23. As per claims 65, 74 and 83

Itabashi discloses wherein the authentication information comprises an equipment identifier that uniquely identifies the client device (6:44-57, 7:8-20)

Itabashi discloses wherein authenticating the consumer comprises verifying the equipment identifier (6:44-57, 7:8-20).

24. As per claims 66, 75 and 84

Itabashi discloses wherein the transaction involves a vendor providing a product or service to the consumer (Figure 5, 1:16-29).

25. As per claims 67, 76 and 85

Itabashi discloses wherein the transaction involves receiving at least one data file from the vendor server and storing the data file in the information account (Figure 7, Figure 9, element S82, Figure 10A, element S102, 11:1-17, 11:49-53, 12:1-8, 12:27-33) (Examiner notes that the service can be set up for automatic reply for a particular service provider for a given set of items; therefore as the service provider requests the items it needs these would have to be stored in order to form an automatic reply, particular when having an access counter monitoring the automated replies. In addition the term of exchange is stored as well)

26. As per claims 68, 78 and 86

Itabashi discloses maintaining the information account in a central data repository accessible via the distributed network on behalf of the consumer (Figure 1, element 110, 3:64-4:11).

27. As per claim 70

Itabashi discloses maintaining an information account in a central data depository accessible via a distributed network, the information account comprising a plurality of consumer information elements accessible and modifiable by the consumer (Figure 1, element 110, 3:64-4:11).

Itabashi discloses receiving at a client device a user selection of one of a plurality of ticket templates, each ticket template including one or more of a plurality of types of service-provider-access--privileges for a respective one of a plurality of types of service providers (Figure 9, elements S81-S87, 6:58-7:7, 11:1-13, 11:28-33)

Itabashi discloses receiving a ticket from the client device at a vendor server to perform a transaction, the ticket being generated by the client device in response to the user selection of the ticket template, the ticket identifying the selected information elements and including authorization from the client device for the vendor server to access the selected information elements in the information account (Figure 4, elements S21, S22 and S30, Figure 12, 5:38-46, 5:59-67, 8:15-21, 9:1-11, 10:44-54, 11:14-27, 12:1-8, 13:49-55, 13:61-64)

Itabashi discloses accessing by the central depository the information account to retrieve the selected information elements and providing the selected information elements to the vendor server to complete the transaction.

***Claim Rejections - 35 USC § 103***

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 61-62, 69, 71-72, 79-80 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itabashi in view of Bui (U.S. Patent PG Publication 2009/0157531, hereinafter referred to as Bui).

30. As per claims 61, 71 and 79

Itabashi discloses the limitations of claims 60, 70 and 77; however Itabashi does not explicitly disclose receiving consumer preferences for the transaction from the client device. Bui teaches receiving consumer preferences for the transaction from the client device (0038)

Bui teaches wherein the interacting with the vendor server to request the transaction comprises communicating the consumer preferences to the vendor server (0038).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the information processing apparatus of Itabashi with the payment service capable of being invoked from merchant sites of Bui for the purpose of allowing a customer to make purchases from multiple Internet merchants using only a single user ID and password set (0048).

31. As per claims 62 and 80

Itabashi, while disclosing the limitations of claim 60, does not explicitly retrieving consumer preferences for the transaction from the information account. Bui teaches retrieving consumer preferences for the transaction from the information account (0038).

Bui teaches wherein interacting with the vendor server to request the transaction further comprises communicating the consumer preferences to the vendor server (0038).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the information processing apparatus of Itabashi with the payment service capable of being invoked from merchant sites of Bui for the purpose of allowing a customer to make purchases from multiple Internet merchants using only a single user ID and password set (0048).

32. As per claims 69 and 87

Itabashi, while disclosing the limitations of claim 60, does not explicitly disclose receiving an acknowledgment from the vendor server indicating that the transaction has been completed and storing the acknowledgment in the information account. Bui teaches receiving an acknowledgment from the vendor server indicating that the transaction has been completed and storing the acknowledgment in the information account (Figures 4D and 4G, 0064-0065).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the information processing apparatus of Itabashi with the payment service capable of being invoked from merchant sites of Bui for the purpose of allowing a customer to make purchases from multiple Internet merchants using only a single user ID and password set (0048).

Please note:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Friday 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES D NIGH/  
Examiner, Art Unit 3685